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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/766,196

01/29/2004

Anthony Balloutine

390.0002

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08/31/2006

CAHN & SAMUELS LLP

2000 P STREET NW

SUITE 200

WASHINGTON, DC 20036

EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/766,196

**Applicant(s)**

BALLOUTINE, ANTHONY

**Examiner**

Dmitry Suhol

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's arguments, see Pre-Appeal conference request, filed 5/9/2006, with respect to claims 1-5 have been fully considered and are persuasive. The finality of the rejection has been withdrawn. A new rejection based on newly found reference(s) follows.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano et al (JP 05-193249) in view of Sherman '849. Kumano discloses a sheet having indicia printed there on which disappear over time when in contact with vapor, oxygen or ultraviolet rays in air (see abstract) as required by claim 1. Kumano further teaches that his sheet may carry a variety of indicia including letters/characters, charts, pictures or other indicia as desired (see abstract and paragraph 0001 of translation), where for purposes of claim 1 letter characters are considered to be penmanship improving indicia.

Kumano lacks the teaching of an overlying barrier sheet (as required by claim 1) being of a synthetic polymer (as required by claim 2) or a lightweight aluminum foil (as

required by claim 3). However, Sherman discloses a device which has indicia that disappears over time when in contact with air (much like Kumano) which teaches the use of an overlying barrier sheet (10). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have manufactured the sheet of Kumano with an overlying barrier sheet of Sherman for the purpose of not starting the disappearing reaction until the desired time.

Regarding the material of manufacture of the cover, as required by claims 2 and 3, it would have been obvious to utilize a cover made of a synthetic polymer or lightweight aluminum foil since Sherman does not put forth any constraints regarding the materials used in the manufacture of his barrier (10) but that the barrier prevents air or light from reaching the reactive ink of his invention and the use of any of the above materials would be capable of fulfilling such a function. Furthermore, the specific materials of manufacture of the barrier sheet of applicants invention are considered to be a design choice in that applicants clearly admit that (much like Sherman) any materials may be used with the only constraint being that the barrier prevent the ink from being exposed to air (see applicants specification page 5, lines 3-9).

Regarding the instructions as required by claim 5, it would have been obvious to include a series of instructions located on the barrier sheet as taught by Sherman for the purpose of providing instructions to the user of the device especially since the examiner takes official notice that such construction is conventional (i.e. peel back covers often have instructions stating items like "peel back here", or "pull up and peel back", etc).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano et al (JP 05-193249) and Sherman '849, as stated above, and further in view of Pitts et al '297. Kumano, as modified by Sherman, lacks the explicit teaching that his indicia is a plurality of lines as required by claim 4, however Pitts teaches that it is known to provide a sheet substrate with guide lines that facilitate penmanship and are later removed (col. 1, lines 14-23. Therefore it would have been obvious to include the guide indicia of Pitts with the sheet of Kumano, as modified by Sherman, for the purpose of providing a sheet with guide indicia for writing, especially since Kumano envisions a wide variety of indicia with his sheet (paragraph 0001 of translation).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dmitry Suhol  
Primary Examiner  
Art Unit 3725

ds